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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/937,011	09/20/2001	Hans Leonhard Ohrem	MERCK 2306	3074

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EXAMINER

LE, HOA VAN

ART UNIT PAPER NUMBER

1752

DATE MAILED: 04/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/937,011	<b>Applicant(s)</b> OHREM ET AL.	
	<b>Examiner</b> Hoa V. Le	<b>Art Unit</b> 1752	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 29 March 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-8 and 12-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-8 is/are allowed.
- 6) ☒ Claim(s) 12 and 13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>07 March 2002</u> . | 6) <input type="checkbox"/> Other: _____  |

This is in response to Papers filed on 29 march 2004.

I. The following is an examiner's statement of reasons for allowance: WO98/50355 being published on 12 November 1998 having its English equivalent specification US 6,222,033 to Fuchs et al disclose, teach and suggest a reactor system tubular and heatable stirred reactor but fail to specify "cannot contain solids" or "solid free zone as claimed. Accordingly, claims 1-8 are allowable.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

II. A product-by-process\* or process-by-process\* using the product made by the cited process\* has and is given a little to no to in product or process claim until applicants could be able to show or provide an unusual or unexpected result of the product made by the cited process\* such as product purity, dissolution, melting for each of every intended use material and/or process. A careful study of the instant application unveils that no such evidence could be shown or provided for the record for the allowability of the product-by-process\* or process-by-process\*. Applicants are urged and requested to come forth ward with such evidence to speed up the prosecution and to avoid any further work that may be later required. A claim would have no value if there is a product in the art that is about the same or would provide about the same

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property or result for the intended use in the claimed process as that of the material of the general formula I in the claims being later shown or provided. Applicants are now notified.

III. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 12-16 are provisionally rejected under 35 U.S.C. 102(a or b) as being anticipated by GB 2,046,506, K.M. Abraham..., DE 3419279, B. Cleaver..., DE 3718920, FR 2168912 or Friedman. Applicants are requested and required to provide the publications and English language equivalents of the foreign documents at the same time or no later than the filing of an appeal brief. Otherwise, the brief is not considered and dismissed.

The authors in the publications and documents as discussed as prior art on pages 1 and 2 of the instant specification as clearly pointed out above disclose, teach and suggest a manufacturing compound being read within the general formula I as claimed and its uses and processes as claimed. Accordingly, claimed materials its uses and processes are publicly disclosed, taught and suggested by the authors. Therefore, the above claims are found to be anticipated by the authors. A product-by-process\* or process-by-process\* using the product made by the cited process\* has and is given a little to no to in product or process claim until applicants could be able to show or provide an unusual or unexpected result of the product made by the cited process\* such as product purity, dissolution, melting for each of every intended use

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material and/or process. A careful study of the instant application unveils that no such evidence could be shown or provided for the record for the allowability of the product-by-process\* or process-by-process\*. Applicants are urged and requested to come forth ward with such evidence to speed up the prosecution and to avoid any further work that may be later required. A claim would have no value if there is a product in the art that is about the same or would provide about the same property or result for the intended use in the claimed process as that of the material of the general formula I in the claims being later shown or provided. Applicants are now notified.

IV. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 12-16 are provisionally rejected under 35 U.S.C. 103(a) as being unpatentable over GB 2,046,506, K.M. Abraham..., DE 3419279, B. Cleaver..., DE 3718920, FR 2168912 and Friedman. Applicants are requested and required to provide the publications and English language equivalents of the foreign documents at the same time or no later than the filing of an appeal brief. Otherwise, the brief is not considered and dismissed.

The basic for the rejection is essentially the same as that set forth the above rejection in paragraph "III" above.

V. Claims 12-14 are rejected under 35 U.S.C. 102(b) as being anticipated by Nardi et al (4,117,207).

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Nardi et al disclose, teach and suggest  $\text{NaAlCl}_4$  compound being read within the general formula I as claimed. Please see the whole disclosure of the applied reference, especially at an operative thermal primary battery at a melting range 165-2500C at col.2:3-11 and col.5 about line 42. Since Nardi et al disclose, teach and suggest the claimed compound and its use, claims 12-14 are found to be anticipated by Nardi et al. A product-by-process\* using the product made by the cited process\* has and is given a little to no to in product or process claim until applicants could be able to show or provide an unusual or unexpected result of the product made by the cited process\* such as product purity, dissolution, melting for each of every intended use material. A careful study of the instant application unveils that no such evidence could be shown or provided for the record for the allowability of the product-by-process\*. Applicants are urged and requested to come forth ward with such evidence to speed up the prosecution and to avoid any further work that may be later required. A claim would have no value if there is a product in the art that is about the same or would provide about the same property or result for the intended use as that of the material of the general formula I in the claims being later shown or provided. Applicants are now notified.

VI. Claims 12-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nardi et al (4,117,207).

The basic for the rejection is essentially the same as that in paragraph "V" above.

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VII. There are a lot more of the patents, publications and documents that would disclosed, taught and suggested a compound being read on the general formula I were made and known how to make in the art.

VIII. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hoa V. Le whose telephone number is 571-272-1332.

The examiner can normally be reached from 6:00 AM to 4:00 PM on Monday through Thursday and about the same time of most Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark F. Huff can be reached on 571-272-1385

Applicants may file a paper by (1) fax with a central facsimile receiving number 703-872-9306,

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Hoa V. Le  
Primary Examiner  
Art Unit 1752

HOA VAN LE  
PRIMARY EXAMINER

*Hoa Van Le*

HVL  
05 April 2004